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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------|
| 10/783,434   | 02/20/2004  | Peter Nicholson      | 920709-95578                  | 6373             |
| 79172  | 7590        | 10/19/2009           |                               |                  |
| Duane Morris LLP<br>505 9th Street, N.W.<br>Suite 1000<br>Washington, DC 20004 |             |                      | EXAMINER<br>ISSING, GREGORY C |                  |
|  |             |                      | ART UNIT                      | PAPER NUMBER     |
|  |             |                      | 3662                          |                  |
|  |             |                      | MAIL DATE                     | DELIVERY MODE    |
|  |             |                      | 10/19/2009                    | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/783,434 | <b>Applicant(s)</b><br>NICHOLSON, PETER |  |
|                              | <b>Examiner</b><br>Gregory C. Issing | <b>Art Unit</b><br>3662                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 33-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-32, 38-53 and 55-61 is/are rejected.
- 7) ☒ Claim(s) 12-14 and 54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. The information disclosure statement filed 3/3/06 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it lacks the requirement of 37 CFR 1.98(a)(1)(i) for each page of the IDS to have a proper heading indicating the serial number of the application. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

2. Claims 33-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/27/09.

3. The applicant's traversal of the election of species requirement has been considered.

4. Upon reconsideration and in light of the search for prior art, the election of species requirement is withdrawn. Claims 1-32 and 38-61 are being considered in the instant Office Action.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1-8, 11, 15-32, 39-52, and 55-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Moilanen et al (2005/0068229).

7. Moilanen et al disclose a method and system of compiling assistance data for transmission to a mobile GPS receiver including a network element (Figure 4) comprising the claimed structure of a receiver 412 for receiving satellite information from reference GPS receivers, a communication transmitter 404/411 and a processor 401-403 configured to perform the method of compiling assistance data to be transmitted to the mobile receiver. The processor is configured for receiving the initial dataset 301, determining an approximate position of the mobile terminal 302 (such as by cell-ID, [0071]), determining which satellites are potentially visible to the mobile terminal 304 ([0048]), determining visibilities with respect to the mobile terminal on the basis of a criterion that the satellite will likely be used 305 ([0052]), selecting a plurality of satellites with the best estimated visibilities 306 ([0053]-[0054], and compiling the assistance data to be transmitted to the mobile terminal relating to the selected group of satellites 307. Additionally, it is taught that satellites with poor visibility are determined and the location assistance information is neither compiled nor sent to the mobile terminal (exclusion of satellites). Moilanen et al teach the criterion for determining “visibility” includes elevation angle of a satellite with respect to the mobile terminal location [0048] while also taking into account a model of large obstructions in the vicinity and their locations [0050]. Furthermore, Moilanen et al suggest that it is possible to estimate satellites visible to the mobile terminal using alternatively other methods than based on the elevation angle of a satellite [0051]. The number of satellites may also be determined ([0054]).

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9, 10, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moilanen et al in view of any one of Maki (5,323,163), Sheynblat (6,720,915), Nishikawa et al (4,949,268) and Myers (EP 0874248A2).

10. Moilanen et al teach various criteria regarding the determination of the likelihood of the satellite to be used and the subsequent selection based thereon but does not specify the use of dilution of precision. The selection of satellites for positioning by minimizing the dilution of precision is conventional, if not inherent, in every GPS receiver, as taught by any one of Maki (2:37-40), Sheynblat (Abstract), Nishikawa et al (2:18+) and Myers (7:36+), each of which is directed to compiling satellite selection data. Thus, the selection of satellites on the basis of the criteria of minimizing the dilution of precision in concert with the best visibilities would have been obvious to one having ordinary skill in the art at the time the invention was made for reasons set forth above.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pitt et al (6,650,288) discloses the equivalence of inclusion/exclusion in the selection of satellites for providing a culled list to a mobile terminal wherein the culling of the list may be based on a graduated scale. Furthermore, Pitt discloses the selection of satellites likely to be used by a mobile terminal on the basis of elevation angle and dwell time within a cone of visibility.

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12. Claims 12-14 and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory C. Issing/  
Primary Examiner  
Art Unit 3662

gci